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OFFICE OF PETITIONS

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In re Patent No. 6,342,127 :  
Issue Date: January 29, 2002 :  
Application No. 08/940,203 : DECISION ON PETITION  
Filed: September 29, 1997 : UNDER 37 CFR 1.378(b)  
For: DISTILLATION DEVICE :  
:

This is a decision on the petition under 37 CFR 1.378(b), filed November 22, 2011.

The petition under 37 CFR 1.378(b) for reinstatement of expired patent is hereby **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f).** The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued January 29, 2002. The 3.5 year maintenance fee could have been paid from January 29, 2005 through July 29, 2005 without a surcharge, or with a surcharge during the period from July 30, 2005 through January 29, 2006. Accordingly, the patent expired on January 30, 2006 for failure to timely submit the second maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks item requirement (1) set forth above.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 41(c)(1).

Petitioner asserts that the petition to reinstate the petition was filed "within two months of the day the patent was found to be lapsed." Petitioner further states that "[t]his patent became lapsed unavoidably. Petitioner Possidento had relied on his former Patent attorney, John Halvonik, to

keep him abreast of the scheduling of maintenance fees for the above mentioned patent. Halvonik's registration was suspended from 11/06 to the present. Possidento was unaware that Mr Havlonik's registration was suspended and did not receive correspondence from the PTO as his (applicant's) address was not listed as the correspondence address. Possidento did not receive notice regarding the issue fee from Halvonik. Accordingly, Mr. Possidento was not aware that the patent had lapsed."

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In essence, patentee must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment from the time the payment was due until the filing of a grantable petition. Petitioner has failed to meet this burden.

The patentee fails to assert when and how he first became aware that the patent was expired. Patentee further fails to set forth what actions were taken thereafter in response to learning of the expiration of the patent.

To the extent that Attorney Halvonik was engaged by patentee to track the maintenance fee due date of the instant patent, there is nothing in the record that establishes that the attorney had steps in place to ensure timely payment of the maintenance fee. Thus, it cannot be found that it was reasonable for patentee to rely upon Attorney Halvonik for the purpose of tracking the maintenance fee due date.

Did patentee, who bears the ultimate responsibility for ensuring timely payment of the maintenance fee, make any inquiries of Attorney Halvonik or even the Patent and Trademark Office to determine when and if the maintenance fee was due?

As to petitioner's assertion of non-receipt of any USPTO notice that the maintenance fee was due, petitioner is reminded per MPEP 2575 that:

"Under the statutes and the regulations, the Office has no duty to notify patentees when their maintenance fees are due. It is the responsibility of the patentee to ensure that the maintenance fees are paid to prevent expiration of the patent. The Office will, however, provide some notices as reminders that maintenance fees are due, but the notices, errors in

the notices or in their delivery, or the lack or tardiness of notices will in no way relieve a patentee from the responsibility to make timely payment of each maintenance fee to prevent the patent from expiring by operation of law. The notices provided by the Office are courtesies in nature and intended to aid patentees. The Office's provision of notices in no way shifts the burden of monitoring the time for paying maintenance fees on patents from the patentee to the Office."

In other words, failure to receive a Maintenance Fee Reminder will not relieve the patentee of the obligation to timely pay the appropriate maintenance fee to prevent expiration of the patent, nor will it constitute unavoidable delay if the patentee seeks to reinstate the patent under 37 CFR 1.378(b). See, In re Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a sufficient showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that patentee or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra. Put otherwise, the lack of communication between patentee and Attorney Halvonik is immaterial in the absence of a showing that there were steps in place to ensure timely payment of the fee.

Petitioner has not provided any documentary evidence demonstrating the nature and extent of contractual obligations of the attorneys to establish that the attorney was contractually bound to track the maintenance fee on behalf of patentee. Petitioner has failed to demonstrate that patentee or Attorney Halvonik had implemented steps to schedule and pay the maintenance fee.

Petitioner seemingly attributes the delay in timely submission of the maintenance fee to the suspension of Attorney Halvonik in November 2006. However, the maintenance fee was already expired at the time of suspension. Accordingly, a nexus cannot be found between the expiration of the patent and the suspension of the attorney.

Ultimately patentee bears the responsibility for timely remittance of the maintenance fee. The petition fails to establish that patentee was unavoidably delayed in making the payment from the time that the maintenance fee was due until the filing of a grantable petition. Accordingly, the Office is precluded from accepting the maintenance fee and surcharge. If reconsideration of this decision is not desired, petitioner may request a refund of this fee by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

Petitioner must establish that patentee was aware of the need to pay the maintenance fee, and was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due until the filing of a

grantable petition. Petitioner must establish a nexus between the events complained of and the failure to timely remit the maintenance fee.

Any renewed petition must establish that the entire period of delay from the time that the maintenance fee was due until the time of the filing of a grantable petition has been unavoidable. Petitioner is reminded that any renewed petition should entail an exhaustive effort to establish that the failure to timely pay the maintenance fee was unavoidable as after reconsideration pursuant to 37 CFR 1.378(e), no further reconsideration regarding unavoidable delay will be undertaken.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                    Mail Stop PETITIONS  
                                 Commissioner for Patents  
                                 Post Office Box 1450  
                                 Alexandria, VA 22313-1450

By hand:                   Customer Service Window  
                                 Mail Stop Petitions  
                                 Randolph Building  
                                 401 Dulany Street  
                                 Alexandria, VA 22314

By fax:                    (571) 273-8300  
                                 ATTN: Office of Petitions

The requested revocation of power of attorney/change of address has been entered into the record.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3205.

*/ALESIA M. BROWN/*

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Attorney Advisor  
Office of Petitions